



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,780	01/27/2004	Walid M. Kobrosly	AUS920030608US1	2468

7590 06/16/2006

Mark E. McBurney
International Business Machines Corporation
Intellectual Property Law Dept., Internal Zip 4054
11400 Burnet Road
Austin, TX 78758

EXAMINER

ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/765,780	Applicant(s) KOBROSLY ET AL.	
	Examiner William J. Allen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 15-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer

Art Unit: 3625

programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since the use of technology permits the function of the descriptive material to be realized.

Claim 15 recites "A computer program having code recorded on a computer readable medium..." and appears to be directed to a computer program per se. It is unclear if the claims are directed to a storage medium storing a computer program or the program itself. Assuming the claims are directed to a storage medium storing a computer, it is unclear if the program is computer executable. Proper format should resemble the following:

A computer-readable medium that stores a computer program having code executable by a computer recorded thereon for the distribution of Web Services in a Web communication network with user access via a plurality of data processor controlled interactive Web display stations comprising:

Additionally, the Examiner notes that the various "means enabling" steps should be changed to "instructions enabling" steps to coincide with the computer program.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-6, 8-13, 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Han et al. (US 2002/0143819, herein referred to as Han).**

Regarding claim 1, Han teaches:

a registry of platform independent Web Services available as integratable Web Service modules distributable over the Web from registered suppliers to requesting users (see at least: abstract, 0003, 0005, 0043, 0045, 0168-0168, Fig. 1);

means enabling suppliers to register said integrated Web Service modules being offered by said suppliers for distribution to users at said Web stations (see at least: 0043-0045);

means enabling users of said Web Services to request distribution of such services to their respective Web stations (see at least: 0005, 0006, 0014, 0015, 0142, 0148, Fig. 3, 6, and 7);

means enabling said suppliers of said Web Services to bill users provided with said Web Services to bill requesting users for said Web Services provided over the Web (see at least: 0013, 0132, 0135, 0195); and

means enabling third parties to track said distribution and said billing via the Web (see at least: 0132, 0134, 0141, 0149, 0180, 0195). The Examiner notes that the Syndicator and Billing services represent independent third parties from the Web Service/Content Providers and Subscribers.

Regarding claims 2-6, Han teaches:

(2) *wherein said registry is a Universal Description, Discovery and Integration (UDDI) registry* (see at least: 0003, 0004, 0158, 0168).

(3) *wherein said Web Service modules distributed over the Web are defined in a text based markup language* (see at least: 0003, 0007, 0045, Fig. 1).

(4) *wherein said text based markup language uses an Extensible Markup Language (XML) standard* (see at least: 0003, 0007, 0045, Fig. 1).

(5) wherein said distributed web service modules include interchangeable application program objects (see at least: 0003, 0067, 0090, 0105, 0112). The Examiner, since no definition has been provided, notes that “interchangeable application program objects” have been interpreted to be classes/objects that are exchangeable, map-able, or the like.

Note: Java classes are mapped to the request/response XML schema

(6) *wherein said third party enabled to track said distribution is an independent Web services manager for one selected from the group consisting of said suppliers and said users* (see at least: 0132-0134, 0141, 0149, 0180, 0195, 0074). The Examiner

Art Unit: 3625

notes that the Syndicator and Billing services represent independent third parties from the Web Service/Content Providers and Subscribers.

Regarding claims 8-13 and 15-20, the limitations of claims 8-13 and 15-20 closely parallel the limitations of claims 1-4 and 6. Claims 8-13 and 15-20 are thereby rejected under the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 7, 14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han in view of Vadlamani (US 2002/0161676).**

Regarding claim 7, Han teaches all of the above as noted but does not expressly teach wherein said users and suppliers access the web through an Internet Service Provider, and said ISP includes said web services manager. Vadlamani teaches a system that grants a client access to web services via an ISP and the Internet. The ISP monitors (i.e. tracks) usage amount (i.e. distribution) of the services (see at least: abstract, 0004, 0008, 0012, 0027). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Han to have included *wherein said users and suppliers access the web through an Internet Service Provider, and said ISP includes said web services manager* as taught by Vadlamani in order to an approach to providing web services that is well-adapted for a variety of different users, including one-time users and multiple users (see at least: Vadlamani, 0006).

Regarding claims 14 and 21, claims 14 and 21 closely parallel the limitations from claim 7. Claims 14 and 21 are thereby rejected under the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 2004/0064548 A1 to Adams et al. discloses an autonomic provisioning of network-accessible service behaviors within a federated grid infrastructure
- US 2005/0049980 A1 to Volk discloses a system for charging small amounts on online networks
- US 6,564,253 B1 to Stebbings discloses a content authorization system over networks including searching and reporting for unauthorized content locations
- PTO 892 reference U teaches the use of XML as an object interchange format
- PTO 892 reference V teaches the use of METS in interchanging digital resource objects

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rob Pond can be reached on (571) 272-6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
June 1, 2006



Primary Examiner